Docket No.: 11987-00036-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Christian R. Thomas

Application No.: 10/538,342 | Confirmation No.: 1568

Filed: June 5, 2006 | Art Unit: 1626

For: METHOD FOR PRODUCING 5-CLORO-N-({5S)-2-OXO-3-[4-(3-OXO-4-MORPHOLINYL)PHENYL]-1,3-OXAZOLIDIN-5-YL}METHYL)-2-THIOPHENECARBOXAMIDE | Examiner: Anderson, Rebecca L.

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed April 24, 2009, Applicant hereby provisionally elects Group IX (claims 12, 15 and 16) drawn to the compound of the formula (X). Applicant respectfully traverses and urges reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. An application "shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." (PCT Rule 13.1). Unity of invention is fulfilled "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression 'special technical feature' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (PCT Rule 13.2).

The Examiner argues that the inventions of Group I-X lack unity because the technical feature linking the groups is the compound of formula (I), which is known in WO 01/47919. Applicant respectfully disagrees.

Groups I-X all relate to a single inventive concept. As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to a process for preparing the compound of formula (I). The prior art process disclosed in WO 01/47919 has various disadvantages that have a particularly unfavorable effect when the compound of formula (I) is prepared on an industrial scale. Specification, p. 3, lines 1-3. The invention of Groups I-X all concerns a surprising process to prepare the compound of formula (I) in improved yield in a shortened reaction sequence using storage-stable starting materials that are less toxic than those used in the prior art. Furthermore, the use of protecting groups is avoided, which reduces the number of stages and thus shortens the reaction time. Page 3, lines 21-26.

Therefore, the Patent Office has not established the presence of Applicant's claimed invention in the prior art. Contrary to the Examiner's assertion, the invention of the present application makes a contribution over the reference cited by the Examiner and as such a lack of unity has not been established. Accordingly, Applicant respectfully requests that the Examiner reconsider the restriction requirement and examine all the claims in one application.

Furthermore, unity of invention and novelty was found during the International stage. As shown in the International Search Report, the claims were searched and examined together. As described in MPEP § 1850 subsection I, the unity of invention standard applicable to the International stage is equally applicable during the national stage. Furthermore in MPEP § 1850 subsection II, "the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Searching Authority." The International Searching Authority applying the correct standard for unity of invention under PCT Rules 13.1 and 13.2 found that unity exists.

Moreover, PCT Article 27 entitled "National Requirements," provides in part "(1) No national law shall require compliance with requirements relating to form or contents of the

international application different from or additional to those which are provided for in this Treaty and the Regulations." Thus under PCT Article 27(1), the issue of lack of unity of invention should not be raised in the national phase of a PCT application when the issue was not raised during the PCT phase. Because there was no lack of unity rejection during the international phase by the International Searching Authority, such a restriction is unjustified in the national phase of the present application.

Alternatively, at least Groups I, IV, V, VI, VII, VIII, and IX should be examined together. Pursuant to 37 CFR 1.475(b), an application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to only one of the listed combinations. One of those listed combinations is a product, a process specially adapted for the manufacture of the product, and a use of the product. Elected Group IX concerns claims 12, 15 and 16 directed to the compound of formula (X). Groups I, V, VI, VII, and VIII concern claims 1, 5-11 and 14 that are directed to uses of the compound of formula (X). Group IV concerns claim 4 directed to a process specially adapted for preparing a compound of formula (X). Accordingly, at least Groups I, IV, V, VI, VII, VIII, and IX should be examined together.

CONCLUSION

For at least the above reasons, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn. Alternatively, Applicant requests that at least Groups I, IV, V, VI, VII, VIII, and IX be examined together.

Applicant reserves all rights to pursue the non-elected claims in one or more divisional applications.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be

filed or which should have been filed herewith to our Deposit Account No. 03-2775, under Order No. 11987-00036-US.

Dated: May 22, 2009

Respectfully submitted,

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